

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANTS: Paul Swenson and Lori L. Oakason	<div><p><b><u>CERTIFICATE OF MAILING</u></b> <b><u>UNDER 37 C.F.R. § 1.8</u></b></p><p>DATE OF DEPOSIT: <b><u>February 22, 2011</u></b></p><p>I hereby certify that this paper or fee (along with any paper or fee referred to as being attached or enclosed) is being submitted on the date indicated above via:</p><p><input checked="" type="checkbox"/> EFS Web <input type="checkbox"/> facsimile to _____ <input type="checkbox"/> the United States Postal Service with sufficient postage as first class mail addressed to: Mail Stop _____, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.</p><p>_____ /Nicole Solomon/ Nicole Solomon</p></div>
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ART UNIT: 3684	
EXAMINER: Benjamin S. Fields	
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APPELLANTS' APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
Mail Stop Appeal Brief – Patents

Sir:

Appellants submit this Appeal Brief in connection with their appeal from the final rejection of the Patent Office, filed August 26, 2010, for the above-identified application. A Notice of Appeal and fees for an extension of time was submitted on November 19, 2010. Pursuant to 37 C.F.R. § 1.136(a), it is respectfully requested that the shortened statutory period be extended one month. The fees in the amount of \$65.00 pursuant to 37 C.F.R. § 1.17(a) are enclosed herewith via Credit Card payment.

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I. REAL PARTY IN INTEREST

The real party in interest is Healing Field, Inc., a corporation established under the laws of the State of Utah and having a principal place of business at 9390 S. 300 West, Sandy, UT 84070, U.S.A.

II. RELATED APPEALS AND INTERFERENCES

Appellants and Appellants' legal representatives know of no other appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-2, 4-9, 11-18, 20 and 21 are pending. Claims 1-2, 4-9, 11-18, 20 and 21 stand rejected. Claims 3, 10 and 19 have been cancelled. The claims on appeal in this application are claims 1-2, 4-9, 11-18, 20 and 21.

IV. STATUS OF AMENDMENTS

Amendments to the presently pending claims were submitted on November 5, 2010 pursuant to 37 C.F.R. § 41.33 to present the rejected claims in a better form for consideration on appeal under 37 C.F.R. § 41.33(a) and § 1.116(b)(2). Specifically, claims 11 and 12 were amended to overcome a 35 U.S.C. § 112 rejection that was first raised by the Examiner in the Final Office Action dated August 26, 2010. The Examiner refused to enter the amendments, claiming that they would require additional searching. The proposed amendments to claims 11 and 12 were entered in the record by the Examiner for purposes of appeal. Therefore, the proposed amendments to claims 11 and 12 are not shown in the attached claims appendix in Section VIII.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 recites a method for raising funds for a charitable cause. (Specification, page 1, line 33). The method includes identifying a charitable cause in need of funding (Page 2, lines 31-32) and selecting a graphic layout for a healing field that is comprised of a plurality of flags positioned in a predetermined pattern. (Page 2, lines 33-34; page 4, lines 14-19). One or more sponsors are obtained to fund the charitable cause through paying for the plurality of flags prior to their display. (Page 3, lines 18-24). A selected location is transformed by erecting the plurality of flags at the selected location to comprise the healing field. (Page 4, lines 7-9). A display of the healing field is linked to the charitable cause in need of funding by carrying out a public awareness campaign to associate the charitable cause with the healing field. (Page 3, lines 14-31; Page 4, lines 22-26). The healing field is displayed as part of the public awareness campaign. (Page 4, lines 20-26). At least some of the plurality of flags that are displayed in the healing field after a predetermined display period are sold to raise additional funds for the charitable cause in need of funding, thereby removing the plurality of flags from the location. (Page 4, lines 27-30).

Independent claim 21 recites a method for raising funds for a charitable cause. The method comprises the operation of identifying a charitable cause in need of funding. (Page 2, lines 31-32). One or more sponsors are obtained to fund the charitable cause by paying for a plurality of flags prior to their display. (Page 3, lines 18-24). A graphic layout is selected for a healing field that is comprised of the plurality of flags positioned in a predetermined pattern. (Page 2, lines 33-34; page 4, lines 14-19). The plurality of flags are provided to comprise the healing field that is, at least in part, expressive of the charitable cause. (Page 2, line 34 to Page 3, line 13). A display of the healing field is linked to the charitable cause in need of funding by

carrying out a public awareness campaign to associate the charitable cause with the healing field. (Page 3, lines 14-31). The healing field is displayed as part of the public awareness campaign. (Page 4, lines 7-8) The plurality of flags temporarily occupy a location not dedicated to providing a permanent display of the flags. (Page 4, lines 9-12; 27-30). At least some of the plurality of flags that are displayed in the healing field are sold and a portion of the proceeds is donated to the charitable cause in need of funding. (Page 4, lines 27-28). The plurality of flags can be removed to eliminate the healing field from the location. (Page 4, lines 28-30).



VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues presented for review are:

- a. Whether independent claims 1 and 21, and dependent claims 2, 4-9 and 11-18 are unpatentable under 35 U.S.C. § 101 as being directed to non-statutory matter;
- b. Whether claims 11-12 are unpatentable under 35 U.S.C. § 112, second paragraph, as being indefinite.
- c. Whether independent claims 1 and 21 and dependent claims 2, 4-9, and 11-18, are unpatentable under 35 U.S.C. § 103(a) as being obvious over, "FREEDOM FIELD" < URL: <http://www.bright.net> >, March 2001 [retrieved by USPTO on 2005-04-11], retrieved from the internet at: < URL: <http://www.archive.org> >, hereinafter "Exhibit U", in view of Harmon et al. (US PG Pub. No. 2004/0181468), hereinafter "Harmon."

## VII. ARGUMENT

### A. Appellants' invention

Charitable organizations have attempted to overcome the problems associated with fundraising using a variety of methods. One commonly used method involves distributing paraphernalia imprinted with the name or logo of a charitable organization. While this method can keep overhead costs low, merely placing a charitable organization's logo in a public place does not necessarily educate the public about the charitable organization or encourage the public to donate funds. (See specification, page 2, lines 20-27).

The present invention discloses a method for charitable fundraising that can reduce overhead while increasing public awareness of the charitable organization, and its ability to raise substantial funds. The method includes identifying a charitable cause in need of funding. (Specification, page 2, lines 31-32).

A healing field is designed for the charitable cause. The healing field comprises an array of flags that can be associated with a historical event, typically including an emotional aspect sensitive to a group or public sector. A historical event can be any event which has occurred in the past which establishes a memory associated with the historical event. Historical events can include those relating to soldiers, policemen, firemen, and other people that are giving lives of service. Historical events may also include events relating to historical figures such as Abraham Lincoln and Martin Luther King. Historical events may include the impact of diseases. For example, historical events may include making others aware of deaths caused by diseases such as cancer or degenerative diseases. Historical events may also include events promoting awareness of issues, such as child abuse or spousal abuse, wherein each flag in a healing field may represent someone who has been a victim of abuse. A

healing field is an array of flags that can invoke a person's sympathies and memories concerning the historical event that the healing field represents. (Specification, page 2, line 34 to page 3, line 13).

The method involves linking a display of the healing field to the charitable cause in need of funding. Linking the display to the charitable cause can involve educating the public about the charitable cause and how the healing field relates to the charitable cause. Education can be accomplished through corporate sponsorship and advertising, using media such as radio, television, posters, signs in businesses, churches, clubs, public places, and any other form of communication that can educate the public. Sponsors can go door to door educating people about the field of flags and what it represents. Churches, clubs, organizations, businesses, and corporations can sponsor single flags or groups of flags prior to their display in the field of flags. (Specification, Page 3, lines 14-31).

Once the flags have been purchased through public or private donations, the flags can be displayed in the healing field as part of a public awareness campaign. The healing field can be displayed in a public or private location where the public may view the flags. The healing field can be an array of dozens of flags to tens of thousands of flags. The healing field can be arranged in a geometric pattern that can catch the eye of the public. (Specification, Page 4, lines 5-13).

The display of the flags in the healing field can encourage the public to become more familiar with the charitable cause that relates to the healing field. The display of the healing field, together with literature and advertisements explaining the purpose of the healing field can educate the public about the historical event and encourage them to donate to the charitable cause that is in need of funding. (Specification, Page 4, lines 20-26).

After the flags have been displayed for an appropriate amount of time in the healing field, the flags can be sold and the proceeds donated to the charitable cause in need of funding. The flags may be sold through another advertising campaign. Alternatively, those coming to see the field of flags may wish to purchase a flag and take it home once the display is completed. The emotional response provoked by the healing field can be used to increase the value of the flags used to create the field, thus increasing the profits that can be donated to the charitable cause. Thus, the invention recited in independent claims 1 and 21 provides a method for raising funds for a charitable organization that can reduce overhead, increase public awareness of the charitable organization, and raise a substantial amount of the funds needed by the charitable organization.

B. The Asserted References

1. Exhibit U

Exhibit U discloses plans for a "Freedom Field" that is designed as a planned 30 acre national park and museum dedicated to the honor of the United States Flag. (See Exhibit U, page 1). The Freedom Field is designed as a permanent display located at I-75 Exit 111 in Wapakoneta, Ohio. The Freedom Field design includes buildings, gardens, walks, parade grounds, memorial markers, statues, and a center monument displaying a 30' by 50 ' United States Flag. (See Exhibit U, page 2). More specifically, a "Flags of Freedom Monument" is designed to include 5 base pools forming the shape of a star that is encircled by three rings of walks displaying all state and colonial flags and their history.

To raise money to create the Freedom Field, an offer is made to sell bricks for \$50.00 each. The bricks are permanently imprinted with the purchaser's name, city and state. (Exhibit U, page 4). The imprinted bricks will then be used to create the

path for the "Freedom Walk", an eight-foot wide sidewalk winding throughout the park. The walk is designed to be mapped into sections so that contributors can easily locate their brick. (Exhibit U, page 2).

## 2. The Harmon Reference

The Harmon reference discloses a method of funding a charity in which an item associated with a charity is sold at a first price to a first buyer, and then resold at an increased price to a second buyer, with portions of each sale donated to the charity. (See Harmon, FIG. 2; ¶ [0004], [0005]). Harmon gives several examples of tickets to concerts or sporting events that may increase in price due to issues of limited supply and high demand. For example, a popular rock concert may have more demand than supply. (See Harmon, ¶ [0028]). This can create a condition in which the ticket may be purchased and resold at an increased cost. (See Harmon, ¶ [0031]). Thus, high demand and relatively low supply are requisite in order for the price of the product to increase. (See Harmon, ¶ [0026]).

## C. Rejections Under 35 U.S.C. § 101

The Examiner has rejected independent claims 1 and 21 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Examiner cites the U.S. Supreme Court decision *Benson* in the Office Action mailed on August 26, 2010, stating that "A claimed process is eligible for patent protection under 35 U.S.C. § 101 if: '(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.' See *Benson*, 409 U.S. at 70." (Office Action, Page 3).

Independent claims 1 and 21 are not tied to a particular machine. However, the process recited in the claims does include a transformation. Particularly, the process involves the operations of:

selecting a graphic layout for a healing field that is comprised of a plurality of flags positioned in a predetermined pattern; and  
transforming a selected location by erecting the plurality of flags at the selected location to comprise the healing field ...

Thus, a graphic layout can be designed to arrange the flags for a selected location, such as a public park, around a public or private building, along a lake, a river, a path, or another location that would allow the public to view the healing field. (See specification, page 4, lines 9-12). The selected location can then be transformed by erecting the plurality of flags at the selected location to comprise the healing field. As anyone who has seen a large healing field displayed can attest, the physical transformation can be breathtaking when an empty park or field is transformed to a healing field displaying hundreds or thousands of flags arranged in a geometric pattern.

The Examiner argues on page 4 of the Office Action that the use of a machine or transformation "does not transform [an] unpatentable principle into [a] patentable process if [the] recited machine or transformation test constitutes mere 'insignificant post-solution activity.'"

The Appellants strongly assert that the transformation of an empty location into a field of flags cannot be considered mere insignificant post-solution activity, as suggested by the Examiner. Rather, the transformation process of creating the field of flags is integral to the entire invention. Without the creation of the field of flags, the

present invention will not function as a method for raising funds for a charitable cause.

Moreover, in the recent *Bilski* decision, the Court held that the machine-or-transformation test does not define what is (and is not) a patentable process. Rather, the Court held that the machine-or-transformation offers “a useful and important clue, an investigative tool, for determining whether some claimed inventions are processes under §101. The machine-or-transformation test is not the sole test for deciding whether an invention is a patent-eligible process”. In *re Bilski*, 561 U. S. \_\_\_\_ at Syllabus, page 2 or Kennedy Opinion, page 8 (2010).

Thus, even a finding that the transformation of the selected location into a field of flags is not considered a transformation, as recited in *Bilski*, would not result in a finding that claims 1 and 21 are directed to non-statutory subject matter.

One thing that all nine justices in the *Bilski* decision agreed upon is that *Bilski*’s method of hedging risk was not patentable because it was an abstract idea just like the algorithms at issue in *Benson* and *Flook*. The Court stated:

The concept of hedging, described in claim 1 and reduced to a mathematical formula in claim 4 [of *Bilski*], is an unpatentable abstract idea, just like the algorithms at issue in *Benson* and *Flook*. Allowing petitioners to patent risk hedging would preempt use of this approach in all fields, and would effectively grant a monopoly over an abstract idea.

Petitioners’ remaining claims are broad examples of how hedging can be used in commodities and energy markets. *Flook* established that limiting an abstract idea to one field of use or adding token postsolution components did not make the concept patentable. That is exactly what the remaining claims in petitioners’ application do. These claims attempt to patent the use of the abstract idea of hedging risk in the energy market and then instruct the use of well-known random analysis techniques to help establish some of the inputs into the equation. Indeed, these claims add even less to the underlying abstract principle than the invention in *Flook* did, for the *Flook* invention was at least directed to the narrower domain of signaling dangers in operating a catalytic converter. (*Id.*, at Syllabus, page 3).

The Court's concern with abstract ideas is the preemption of other fields and the granting of a monopoly over an abstract idea. In the Flook, Benson, and Diehr cases cited by the Supreme Court, as well as in the O'Reilly v. Morse (56 U.S. 62, 1853) case referenced in each of the Flook, Benson, and Diehr cases, ideas considered abstract were either explicitly directed to non-statutory subject matter or where the claims were so broadly drafted as to encompass other technologies or areas of technologies not contemplated and/or not supported by the written description.

For example, in O'Reilly v. Morse, Morse was allowed a patent for a process of using electro-magnetism to produce distinguishable signs for telegraphy. *Id.*, at 111. The Court denied a claim in which Morse claimed the use of electro-magnetism for marking or printing intelligible characters, signs, or letters, at any distance. The Court in disallowing that claim said, "If this claim can be maintained, it matters not by what process or machinery the result is accomplished. For aught that we now know some future inventor, in the onward march of science, may discover a mode of writing or printing at a distance by means of the electric or galvanic current, without using any part of the process or combination set forth in the plaintiff's specification." *Id.*, at 113.

Appellants submit that: first, independent claims 1 and 21 of the present application are not directed toward non-statutory subject matter such as laws of nature, natural phenomena, mathematical algorithms, etc.; and second, the claims are narrowly tailored and are not so broad as to encompass other technologies or areas of technologies not contemplated and/or not supported by the written description.

Specifically, independent claim 1 is directed to a method for raising funds for a charitable cause. The claims include, in part, the narrowly tailored limitations identifying a charitable cause, selecting a graphic layout for a healing field, obtaining one or more sponsors to fund the charitable cause through paying for the plurality of



flags, transforming a selected location by erecting the plurality of flags, linking a display of the healing field to the charitable cause, displaying the healing field, and selling at least some of the plurality of flags. Claim 21 includes similarly tailored limitations. Thus, in view of the U.S. Supreme Court decisions in *Flook*, *Benson*, *Diehr*, *O'Reilly*, and *Bilski*, the claims of the present application are narrowly tailored and are not abstract.

Therefore, Appellants submit that the rejection of independent claims 1 and 21 and dependent claims 2, 4-9 and 11-18 under § 101 should be overturned.

D. Rejections Under 35 U.S.C. § 112

1. Requirements for claims to be found indefinite under § 112, second paragraph

The Examiner has rejected dependent claims 11 and 12 under § 112, second paragraph as being indefinite. Claims are found indefinite only where a person of ordinary skill in the art could not determine the metes and bounds of the claims. (*Energizer Holdings, Inc. v. Int'l Trade Comm'n*, 435 F.3d 1366, 1370-1371 (Fed. Cir. 2006)). If the language of a claim, considered as a whole in light of the specification and given its broadest reasonable interpretation, is such that a person of ordinary skill in relevant art would read it with more than one reasonable interpretation then a rejection under 35 U.S.C. § 112, second paragraph is appropriate. (MPEP 2173.05(a)). “Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say.” MPEP § 2111.01 I (citing *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004)).

2. The rejection of Claims 11 and 12 under 35 U.S.C. 112, 2<sup>nd</sup> paragraph

Claims 11 and 12 were rejected as being indefinite under § 112, 2<sup>nd</sup> paragraph.

Specifically, the Examiner stated that the terms "obtaining a person" in claim 11 and "obtaining an organization" are not clear and require appropriate correction.

Claims 11 and 12 provide additional limitations on the element of Claim 1 that recites "obtaining one or more sponsors to fund the charitable cause through paying for the plurality of flags prior to their display." Claim 11 recites "wherein obtaining the one or more sponsors further comprises obtaining a person that pays to sponsor one or more flags in the plurality of flags." Similarly, claim 12 recites "wherein obtaining the one or more sponsors further comprises obtaining an organization that pays to sponsor one or more flags in the plurality of flags.

The specification discloses that "[s]ponsors may even go door to door, educating people and businesses about the field of flags and what it represents. Sponsorship of flags in the healing field is not limited to individuals. Churches, clubs, organizations, businesses, and corporations can sponsor single flags or groups of flags." (Page 3, lines 27-30).

Under MPEP 2111.01, construing the terms to mean exactly what they say, it is clear to a person of ordinary skill in the relevant art that claim 11 refers to a sponsor that is an individual person, while claim 12 refers to obtaining a sponsor that is an organization. Based on the language of the claim, and the teachings of the specification, this is the only clear meaning.

However, to placate the Examiner and provide the clearest possible claims, Appellants filed a post-final amendment under 37 C.F.R § 1.116 dated November 5, 2010 and amended claims 11 and 12 to clarify the language. In the post-final amendment, claims 11 and 12 were amended as follows:

11. (currently amended) A method as in claim 1, wherein obtaining one or more sponsors further comprises obtaining one or more sponsors, wherein each sponsor is ~~the one or more sponsors~~ comprise a person that pays to sponsor one or more flags in the plurality of flags.

12. (currently amended) A method as in claim 1, wherein obtaining one or more sponsors further comprises obtaining one or more sponsors, wherein each sponsor is ~~the one or more sponsors~~ comprise an organization that pays to sponsor one or more flags in the plurality of flags.

The Examiner refused to enter the amendments, claiming that doing so would require additional searching. Appellants question how the above amendment would require additional searching. However, Appellants can amend the claims after the decision by the BPAI based on the present appeal brief to provide the desired clarification, if necessary.

Even without the clarification, Appellants assert that the language of claims 11 and 12, considered as a whole in light of the specification and given its broadest reasonable interpretation, is such that a person of ordinary skill in the relevant art would read it with a single reasonable interpretation.

Therefore, Appellants submit that the rejection of claims 11 and 12 under § 112, 2<sup>nd</sup> paragraph should be overturned.

It is noted that a specification identifier (Page 2, lines 31-32) was inadvertently included with claim 1 in the last amendment. This identifier can be removed by Examiner's amendment after the appeal process. Although included in error, it is

currently included in the claims in the Appendix to show the claims as they now stand.

E. Rejections Under 35 U.S.C. § 103(a)

1. Requirements for Prima Facie obviousness

The Examiner has rejected all of the pending claims under § 103(a) as being *prima facie* obvious over a number of references. The Patent and Trademark Office (PTO), through the Examiner, has the burden of establishing a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1998). To satisfy this burden, the PTO must set forth a *prima facie* case of obviousness under any one of the rationales identified by the Supreme Court in *KSR International Co. v. Teleflex, Inc.* (550 U.S. 398) (2007). Such rationales can be found in MPEP § 2143, and include:

- 1) Combining prior art elements according to known methods to yield predictable results;
- 2) Simple substitution of one known element for another to obtain predictable results;
- 3) Use of known technique to improve similar devices (methods, or products) in the same way;
- 4) Applying known technique to a known device (method, or product) ready for improvement to yield predictable results;
- 5) “Obvious to try” - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

6) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if variations are predictable to one of ordinary skill in the art;

7) Some teaching, suggestion, or motivation in the prior art [including the references themselves and/or the knowledge generally available to one of ordinary skill in the art] that would have led one of ordinary skill in the art to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. (TSM Test)

In addition to the rationales set forth above, the obviousness analysis must comply with the statutory scheme as explained by the Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), namely, consideration must be given to: (1) the scope and content of the prior art, (2) the differences between the prior art and the claimed invention, (3) the level of ordinary skill in the pertinent art, and (4) additional evidence, which may serve as indicia of non-obviousness.

An excellent summary of how the prior art must be considered to make a case of *prima facie* obviousness is contained in *In re Ehrreich et al.*, 220 U.S.P.Q. 504, 509-511 (CCPA 1979). There the court states that a reference must not be considered in a vacuum, but against the background of the other references of record. It is stated that the question of a § 103 case is what the reference(s) would "collectively suggest" to one of ordinary skill in the art. However, the court specifically cautioned that the Examiner must consider the entirety of the disclosure made by the reference and avoid combining them indiscriminately.

In finding that the "subject matter as a whole" would not have been obvious in *Ehrreich* the court concluded:

"Thus, we are directed to no combination of prior art references which would have rendered the claimed subject matter as a whole obvious to one of ordinary skill in the art at the time the invention was made. The PTO has not shown the existence of all the claimed limitations in the prior art or any suggestion leading to their combination in the manner claimed by applicants." (underlining added)

It has been widely recognized that virtually every invention is a combination of elements and that most, if not all, of these will be found somewhere in an examination of the prior art. This reasoning lead the court, in *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983) to state:

"...it is common to find elements or features somewhere in the prior art. Moreover, most if not all elements perform their ordained and expected function. The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made." (underlining added)

With the above background in mind, Appellants contend that the Examiner has not met this burden with respect to any of the claims on appeal. Particularly, Appellants submit that the PTO has failed to show that each and every element of the claimed invention is contained in the combined references and/or that the references are properly combined. Appellants now turn to a discussion of the individual rejections at issue, and the references on which they are based.

2. The rejection of Claims 1-2, 4-9, 11-18, and 20-21 over Exhibit U in view of Harmon

According to M.P.E.P. § 706.02(j), to render a claim prima facie obvious, the asserted prior art reference (or references when combined) must teach or suggest all of the claim limitations. Appellants submit that the combination of Exhibit U and Harmon asserted by the Examiner simply does not teach or suggest each and every element of the rejected claims.

The Exhibit U reference discloses a permanent memorial-type structure and place of visit, namely a planned 30 acre national park and museum dedicated to the honor of the U.S. flag. (See page 1). The reference discloses plans for a memorial containing over one-hundred permanent granite memorial markers, as well as a “Flags of Freedom Monument” containing state and colonial flags located around 5 pools forming the shape of a star. However, Exhibit U does not teach or suggest identifying a charitable cause in need of funding, as recited in independent claim 1. Nor does Exhibit U teach or suggest a sponsor that initially pays for flags to be displayed in a field, followed by selling the flags displayed in the field to raise additional funds. Indeed, there is no discussion in Exhibit U about selling flags or other objects that were previously purchased through donations from sponsors. Any income raised in Exhibit U is limited to donations made for permanent display of the of the memorial markers. Thus, a display such as the national park and museum disclosed in Exhibit U would very likely not be considered by one skilled in the art to be used for fund raising efforts such as breast cancer, child abuse, and so forth. Accordingly, the only type of fund raising discussed in Exhibit U is raising funds to build the exhibit itself.

In contrast to the teachings of Exhibit U, claim 1 of the present application recites, in part, the operation of identifying a charitable cause in need of funding. (See page 2, lines 32-32). The charitable cause can be a wide variety of different subjects. For example, the specification provides examples related to church congregations, communities, cities, states, or a nation. The charitable cause can relate to historical figures, the fight against diseases such as cancer or muscular dystrophy, and so forth. The method recited in claim 1 can be used to raise funds for a wide number of charitable causes rather than being limited to donations for the construction

of a specific park or museum as taught in Exhibit U. Thus, Exhibit U does not teach or suggest the ability to identify a charitable cause in need of funding.

Claim 1 further recites the operation of obtaining one or more sponsors to fund the charitable cause by paying for a plurality of flags. At least some of the plurality of flags that are displayed in the healing field are then sold after the field of flags has been displayed for an appropriate amount of time to allow the public to become familiar with the purpose behind the healing field. (See specification, page 4, lines 27-30). The flags are sold to raise additional funds for the charitable cause in need of funding. This provides additional fund raising ability for a charity than the traditional method disclosed in Exhibit U.

In addition, by selling the flags to additional donors when the display period of the healing field is completed, the public awareness of the charitable cause is further spread. Flags are often used to commemorate emotional events because they promote an emotional response in people. Once the healing field has been taken down, the flags can be displayed at numerous locations by different purchasers, enabling public attention to the charitable cause to be furthered even after the healing field is taken down. Thus, the present method can be used both to increase the profits that can be donated to the charitable cause, as well as to increase the public attention to the charitable cause. (See specification, page 5, lines 4-10).

Exhibit U only discloses a traditional fundraising method. Particularly, Exhibit U discloses that bricks can be sold for \$50.00 to help fund the construction of the project. When a brick is purchased, the purchaser's information, such as name, city, and state can be printed on the brick. The brick can then be placed along a path in the planned park discussed in Exhibit U. The brick cannot be removed from the permanent park or purchased by another party. Indeed, removing the brick would



destroy the path. In addition, another party would not want to purchase a brick with someone else's personal information inscribed thereon. Moreover, the idea of inscribing personal information is typically used to encourage people to donate (i.e. purchase a brick) so that their personal information can be on permanent display. Thus, if the brick were removed and sold, it would eliminate the incentive for a donor to purchase a brick in the first place. Thus, Exhibit U teaches against the invention recited in claim 1 of having a donor purchase a flag, displaying the flag, and then later selling the flag.

The Harmon reference does not overcome the limitations of Exhibit U. The Harmon reference discloses a method of funding a charity in which an item associated with a charity is sold at a first price to a first buyer, and then resold at an increased price to a second buyer, with portions of each sale donated to the charity. Harmon gives several examples of items used to fund a charity, such as tickets to concerts or sporting events that may increase in price due to issues of limited supply and high demand. For example, a popular rock concert or sporting event may have more demand than supply. (See Harmon, ¶ [0028]). This imbalance between supply and demand can create a condition in which the ticket may be purchased for a first price and resold at an increased price. (See Harmon, ¶[0031]). However, the method disclosed in Harmon is limited to atypical market conditions in which the demand significantly outstrips supply for a selected item. In many types of charitable causes, such as cancer, chronic illnesses, veterans associations, military tributes, and so forth, the law of supply and demand does not create a market condition in which an item can continue to be sold at an increasing cost.

In contrast to the teachings of Harmon, in the present application, as recited in claim 1, an object is not sold to a first buyer, with the option to resell the object to a

second buyer at a higher price. Rather, claim 1 provides that one or more sponsors are used to fund the charitable cause by paying for a plurality of flags prior to their display. The sponsors do not own the flags, with the ability to resell them at a higher price to make money for themselves and/or others. Rather, the sponsors donate money to provide the flags that make the field of flags display possible by paying for the flags prior to their display. In many fundraising situations, charities cannot afford to purchase hundreds, or thousands of flags for display in a healing field. The sponsor donations make it possible to display the flags at a selected location. Neither Harmon nor Exhibit U teach or suggest a sponsor donating to purchase flags prior to their display in a healing field for an identified charitable cause.

Claim 1 of the present invention further recites that a graphic layout is selected for a healing field that is comprised of a plurality of flags positioned in a predetermined pattern. Selection of a graphic layout is important because the graphic image helps to stimulate the desired emotional response from the viewing public. For example, a large array of flags that are positioned in a graphic layout comprising columns and rows creates an atmosphere of reverence, eliciting a spirit of respect and admiration. (See specification, page 4, lines 14-19).

The graphic layout can be selected for a specific charitable cause. By specifically selecting the graphic layout for the selected charitable cause, the emotional response evoked by the layout can be increased. The stimulation of the emotional response provides a value to the flags. Those viewing the healing field can purchase a flag in the display to remind them of the charitable cause associated with the healing field. As previously discussed, this enables additional funding to be provided to the charitable cause. In addition, it enables the flags from the healing

field to be displayed by numerous purchasers over a wide range of locations after the healing field has been taken down.

The price at which the flags in the healing field display are sold, after the flags have been displayed for a predetermined period, is not directly associated with the funds donated by the sponsors that were used to initially purchase the flags prior to their display. It is not necessary to sell a flag at an increased price over its initial purchase price in order to make money for the charitable cause. Any donation can be used to raise additional money. The additional money raised by selling the flags in the display is beneficial to the charitable cause. Thus, the teachings in Harmon of reselling an item for a greater price cannot be attributed to the present invention, as recited in claim 1. Moreover, the teachings of Exhibit U of a static layout of flags is not as effective as the process recited in claim 1, which enables the graphic layout to be selected for the specific charitable cause.

In addition, the teachings of Exhibit U and the Harmon reference cannot be combined. As previously discussed, the Harmon reference discloses a plan for the construction of a 30 acre national park and museum dedicated to honor the U.S. flag. The public can support the project by purchasing bricks for \$50.00 that will be displayed in the park. (See Exhibit U, page 4). The person's name and hometown or state will be printed on their brick. Of course, once a person's personal information is printed on a brick, the ability to resell the brick to another is minimal. The value of the brick to others will fall to near zero, since others can purchase bricks with their own personal information that can be displayed at the park. Thus, the law of supply and demand does not cause the bricks to increase in value. Therefore, the fund raising method disclosed in Harmon cannot be applied to the teachings of Exhibit U.

Exhibit U does not teach or suggest having sponsors pay for a plurality of flags prior to their display, as recited in claim 1. Nor does Exhibit U teach or suggest linking a display of the healing field to the charitable cause in need of funding by carrying out a public awareness campaign, as recited in claim 1. Merely asking for donations for bricks to contribute to building the 30 acre national park and museum is not the same as linking a display of a specifically created healing field for a selected charitable cause. Moreover, the Harmon reference does not overcome these limitations.

The Examiner has failed to set forth a *prima facie* case of obviousness under any of the rationales identified by the Supreme Court in *KSR*. Specifically, the Examiner has provided no articulated rationale for which one of skill in the art would seek to combine the teachings of Harmon and Exhibit U.

Moreover, the Examiner has admitted that the step of "removing the plurality of flags from the selected location", as recited in claim 1, is not taught or suggested in the prior art. The Examiner merely states that removing the flags would have been obvious, without providing any support or articulated reasoning. The concept of removing the plurality of flags is directly contrary to the teachings of the prior art, wherein Exhibit U teaches a permanent display comprised of granite markers, pools, paths, and various buildings "for future generations to enjoy" (See Exhibit U, Page 3). The Examiner provides no reasoning as to why, in view of the teachings of a permanent display in Exhibit U, it would have been obvious to set up a temporary display.

More significant is the fact that the Examiner provides no articulated reasoning of how the cited prior art references teach the concept of linking a display of flags to a

charitable fundraising event, wherein holding the actual event of the display of flags leads to additional fundraising.

The reasoning of the *Connell v. Sears, Roebuck & Co.* is particularly noteworthy when applied to the present case. Indeed, the claimed invention, when taken as a whole cannot be considered to be obvious in light of the Exhibit U and Harmon references.

Thus, as stated in *Ehrreich*, the Examiner has provided no combination of prior art references which would have rendered the claimed subject matter as a whole obvious to one of ordinary skill in the art at the time the invention was made. The PTO has not shown the existence of all the claimed limitations in the prior art or any suggestion leading to their combination in the manner claimed by applicants.

Independent claim 21 has similar limitations as claim 1. Thus, the arguments above also apply to independent claim 21.

Regarding dependent claims 6 and 7, neither Exhibit U nor the Harmon reference teach or suggest displaying a plurality of flags in a predetermined pattern and incorporating information within the predetermined pattern. Nor do the references disclose incorporating a graphic message within the predetermined pattern.

Regarding dependent claim 8, neither Exhibit U nor the Harmon reference teach or suggest advertising a purpose for the plurality of flags and the healing field, wherein the purpose links the plurality of flags and the healing field to the charitable cause.

Regarding dependent claims 11 and 12, neither Exhibit U nor the Harmon reference teach or suggest obtaining sponsors to fund the charitable cause through paying for a plurality of flags prior to their display, wherein the sponsor is a person (claim 11) or an organization (claim 12).

Regarding dependent claims 13, 14, 15, 17 and 18, neither Exhibit U nor the Harmon reference teach or suggest selling the plurality of flags, after they have been displayed for a predetermined display period. There is no discussion of selling flags at an auction or an internet auction as in claims 13 and 14, respectively. There is no discussion of an advertising campaign to sell flags, as in claim 15. As previously discussed, Exhibit U merely teaches that flags will be permanently displayed. This teaches against the concept of selling the flags after they have been displayed. Neither Exhibit U nor Harmon disclose any information about selling flags, either before they have been displayed or after they have been displayed.

Regarding dependent claim 16 neither Exhibit U nor the Harmon reference teach or suggest selling the plurality of flags by placing advertisements near the healing field. Since the flags for the planned park disclosed in Exhibit U are not intended to be sold then advertisements for their sale would not be displayed. The Harmon reference does not overcome this limitation.

Regarding dependent claim 20, neither Exhibit U nor the Harmon reference teach or suggest repeating the steps of identifying a charitable cause, selecting a graphic layout, obtaining one or more sponsors, transforming a selected location, linking a display of the healing field, displaying the healing field, selling the plurality of flags, and removing the plurality of flags for a different charitable cause at a different location. As previously discussed, the plans for the national park and museum disclosed in Exhibit U is intended to be constructed and located at a single, permanent location, suggested to be at I-75 Exit 111, Wapakoneta, Ohio. (See Exhibit U, Page 5). Thus, the exhibit is not portable and cannot be repeated at different locations for different charitable causes, as recited in claim 20.

Rejection of the dependent claims 2, 4, 5 and 9 should be reconsidered and withdrawn for at least the reasons given above with respect to the independent claims. The dependent claims, being narrower in scope, are allowable for at least the reasons for which the independent claims are allowable.

Therefore, Appellants submit that the rejection of independent claims 1 and 21 and dependent claims 2, 4-9, 11-18 and 20 under § 103(a) should be overturned.

CONCLUSION

Appellants respectfully submit that the claims on appeal set forth in the Appendix are patentably distinct from the asserted prior art references. Particularly, none of the asserted combinations of references motivates, teaches, or suggests one of ordinary skill in the art within the meaning of 35 U.S.C. § 103(a) to arrive at the presently claimed invention. Appellants contend that Exhibit U in combination with Harmon fails to teach each and every element of the claimed invention, and furthermore that they provide no motivation to combine them.

For these reasons, Appellants respectfully request that the Board of Appeals reverse the rejection and remand the case to the Examiner for allowance.

Dated this 22<sup>nd</sup> day of February, 2011.

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VIII. CLAIMS APPENDIX

1. (previously presented) A method for raising funds for a charitable cause comprising the steps of:
  - identifying a charitable cause in need of funding; (Page 2, lines 31-32)
  - selecting a graphic layout for a healing field that is comprised of a plurality of flags positioned in a predetermined pattern;
  - obtaining one or more sponsors to fund the charitable cause through paying for the plurality of flags prior to their display;
  - transforming a selected location by erecting the plurality of flags at the selected location to comprise the healing field;
  - linking a display of the healing field to the charitable cause in need of funding by carrying out a public awareness campaign to associate the charitable cause with the healing field;
  - displaying the healing field as part of the public awareness campaign;
  - and
  - selling at least some of the plurality of flags that are displayed in the healing field after a predetermined display period to raise additional funds for the charitable cause in need of funding, and thereby removing the plurality of flags from the selected location.
2. (previously presented) A method as in claim 1, wherein the step of designing the graphic layout for the healing field further comprises the step of identifying a historical event to be symbolized by the plurality of flags.
3. (canceled)
4. (previously presented) A method as in claim 1, wherein the predetermined pattern is a geometric pattern.

5. (previously presented) A method as in claim 1, wherein the predetermined pattern is a linear array placed along an area selected from the group consisting of a path, a body of water, a river, a building, a structure, a road, a highway, a trail, a hill, a mountain, and a military base.
6. (previously presented) A method as in claim 1, further comprising the step of incorporating information within the predetermined pattern.
7. (previously presented) A method as in claim 1, further comprising the step of incorporating a graphic message within the predetermined pattern.
8. (previously presented) A method as in claim 1, wherein the step of linking a display of the healing field to the charitable cause further comprises the step of advertising a purpose for the plurality of flags and the healing field, wherein the purpose links the plurality of flags and the healing field to the charitable cause.
9. (previously presented) A method as in claim 8, wherein the step of advertising the purpose for the plurality of flags and the healing field further comprises the step of advertising through a medium selected from the group consisting of radio stations, television stations, newspapers, magazines, and internet sites.
10. (canceled)
11. (previously presented) A method as in claim 1, wherein obtaining the one or more sponsors further comprises obtaining a person that pays to sponsor one or more flags in the plurality of flags.
12. (previously presented) A method as in claim 1, wherein obtaining the one or more sponsors further comprises obtaining an organization that pays to sponsor one or more flags in the plurality of flags.

13. (previously presented) A method as in claim 1, wherein the step of selling the plurality of flags further comprises the step of selling the plurality of flags through an auction.
14. (original) A method as in claim 13, wherein the auction is an internet auction.
15. (previously presented) A method as in claim 1, wherein the step of selling the plurality of flags further comprises the step of selling the plurality of flags through an advertising campaign.
16. (previously presented) A method as in claim 1, wherein the step of selling the plurality of flags further comprises the step of placing advertisements near the healing field.
17. (previously presented) A method as in claim 1, wherein the step of selling the plurality of flags further comprises the step of advertising through a medium selected from the group consisting of radio stations, television stations, newspapers, magazines, and internet sites.
18. (original) A method as in claim 17, wherein the step of advertising through the medium of magazines further comprises the step of advertising through magazines that are substantially specific to a purpose for the healing field.
19. (canceled)
20. (previously presented) The method of claim 1, further comprising repeating the steps of identifying a charitable cause, selecting a graphic layout, obtaining one or more sponsors, transforming a selected location, linking a display of the healing field, displaying the healing field, selling the plurality of flags, and removing the plurality of flags for a different charitable cause at a different location.

21. (previously presented) A method for raising funds for a charitable cause comprising the steps of:
- identifying a charitable cause in need of funding;
  - obtaining one or more sponsors to fund the charitable cause by paying for a plurality of flags prior to their display;
  - selecting a graphic layout for a healing field that is comprised of the plurality of flags positioned in a predetermined pattern
  - providing the plurality of flags to comprise a healing field that is, at least in part, expressive of the charitable cause;
  - linking a display of the healing field to the charitable cause in need of funding by carrying out a public awareness campaign to associate the charitable cause with the healing field;
  - displaying the healing field as part of the public awareness campaign, the plurality of flags temporarily occupying a location not dedicated to providing a permanent display of the flags;
  - selling at least some of the plurality of flags that are displayed in the healing field and donating at least a portion of proceeds to the charitable cause in need of funding; and
  - removing the plurality of flags to eliminate the healing field from the location.

IX. EVIDENCE APPENDIX

(No matter presented)

X. RELATED PROCEEDINGS APPENDIX

(No matter presented)